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"PATENT APPLICATION"

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

JAMES D. KROL

APPEAL NO.

U.S. Serial No. 10/692,857

Group Art Unit 1761

Filed: October 27, 2003

L. Tran, Examiner

LOW CARBOHYDRATE FOOD PRODUCT  
AND METHOD OF MAKING THE SAME

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Alexandria, Virginia  
July 9, 2007

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

R E P L Y B R I E F

Dear Sir:

This Reply Brief is being submitted in response to the Examiner's Answer mailed May 8, 2007 in order to respond to new points of arguments raised by the Examiner and to avoid acquiescence in the position of the Examiner. If a point raised by the Examiner is not specifically addressed herein, such is not to be understood as acquiescence therein, but rather that appellant relies on the Appeal Brief earlier filed on January 8, 2007.

Additionally, appellant is filing concurrently herewith a Request For Oral Hearing.

The Examiner rejected claims 1-26 under 35 U.S.C. § 103(a) over the recipe for "Crustless Pizza" in view of the Google Group disclosure. As noted in appellant's Appeal Brief, based on the Examiner's comments, appellant understands and addresses the rejection as being directed to the "Deep Dish Pizza" recipe in view of the Google Group disclosure.

The "Deep Dish Pizza" recipe does not disclose a base layer being a formulated flour and cheese mixture wherein the formulated flour is a dry mixture as claimed. In fact, the "Deep Dish Pizza" recipe teaches away from a dry mixture of formulated flour and cheese by disclosing a liquid egg mixture poured over the cheeses in the dish. In response thereto, the Examiner states on page 4 of the Examiner's Answer that "[i]t is not clear how applicant view this as teaching away from a dry mixture." Appellant respectfully submits that the base layer taught by the "Deep Dish Pizza" recipe includes Italian cheeses and a liquid egg mixture. It is known to one skilled in the art that the egg mixture disclosed by the "Deep Dish Pizza" recipe is liquid in nature, not dry. As such, the liquid egg mixture does not stay on top of the cheeses, but rather mixes therewith.

The Google Group disclosure does not make up for the shortcomings of the "Deep Dish Pizza" recipe as set forth above and in appellant's Appeal Brief. On page 5 of the Examiner's Answer, the Examiner states that the "Google disclosure is a low carbohydrate pizza crust with the crust being made of little flour and some whey protein. Since the crust is made of little flour and protein, it is essentially without a crust because regular pizza crust is not made out of just a little flour." Appellant respectfully submits that the Google Group disclosure does not disclose or suggest a pizza without a crust as suggested by the Examiner. Rather, the Google Group disclosure reference discloses "a low carb pizza crust" and that "[t]here are recipes for low carb crusts... ." (Emphasis added). Nothing in the Google Group disclosure teaches or suggests a crustless pizza as suggested by the Examiner and as claimed by appellant. There is no teaching, suggestion or motivation to support the Examiner's statement that the crust of the Google Group disclosure is "essentially without a crust... ." Rather, the Google Group disclosure discloses a pizza crust.

Neither the "Deep Dish Pizza" recipe nor the Google Group disclosure provides any motivation to modify the "Deep Dish Pizza" recipe or the Google Group disclosure

in order to provide appellant's invention as claimed. The motivation to modify the applied art must be found in the applied art itself or in the knowledge generally available to one skilled in the art, and not through hindsight using applicant's disclosure to mosaic the prior art. In re Fine, 5 USPQ2d 1596, 1599-1600 (Fed. Cir. 1988). Further, the mere fact that the prior art can be modified does not make the modification obvious unless the prior art suggests the desirability in the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125 (Fed. Cir. 1984). Thus, once appellant's solution to a problem is disclosed, it is easy to see how a prior art reference or references can be modified and manipulated to produce the claimed invention. The change can appear simple and by hindsight seem obvious. However, as stated in the Court in In re Sporck, 301 F.2d 686, 133 USPQ 360, 363 (CCPA 1962), the simplicity of new inventions is oftentimes the very thing that is not obvious before they are made.

In In re Dow Chemical, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988), the Court, citing Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985), stated that "... selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings." The Patent Office

examiner had rejected claims to a particular polymer based upon a combination of references and the fact that one prior art reference taught a technique that could have been (but never was) used to produce the claimed polymer. The Board of Patent Appeals and Interferences asserted that unless the prior art is shown to have led one of ordinary skill to expect the prior art technique to fail, the applicant's burden of overcoming a prima facie case of obviousness is not met. The Federal Circuit rejected this standard and characterized the Patent Office standard as an improper "obvious to experiment" standard for obviousness. The Court held that both "the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure"; and that there "must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure...." (5 USPQ2d, at 1532). Obvious to try is not the standard of 35 U.S.C. § 103. In re Antonie, 559 F.2d 618, 195 USPQ 6, 8 (CCPA 1977).

Nothing in the "Deep Dish Pizza" recipe or the Google Group disclosure provides any motivation to combine the teachings thereof in order to provide appellant's invention as claimed. The "Deep Dish Pizza" recipe in view of the Google Group disclosure does not disclose or suggest

the base layer being a formulated flour and cheese mixture wherein the formulated flour is a dry mixture as claimed and it would not have been obvious to one skilled in the art to combine these ingredients to make the base layer of the invention as claimed. The mere fact that food ingredients may be combined does not make the combination thereof obvious without some teaching in the prior art to do so.

The rejection of the Examiner makes it clear that the Examiner is selecting select parts of the prior art disclosures based on appellant's own teaching. This is using improper hindsight. Thus, as the Court of Appeals for the Federal Circuit stated in In re Rouffet, 149, F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998):

"As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698; 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570. 38 USPQ2d 1551, 1554

(Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed."

With regard to obviousness, the Supreme Court in KRS Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 82 USPQ2d 1385 (2007), provided that often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See In re Kahn, 441 F.3d 977, 988 (C.A.Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness").

When it first established the requirement of

demonstrating a teaching, suggestion, or motivation to combine known elements in order to show that the combination is obvious, the Court of Customs and Patent Appeals captured a helpful insight. See Application of Bergel, 48 C.C.P.A. 1102, 292 F.2d 955, 956-957 (1961). As is clear from cases, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known. KRS Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007).

In the case at hand, there is no motivation to select the parts of the references selected by the Examiner and to combine them in such a manner as to provide the invention as claimed. Accordingly, the "Deep Dish Pizza" recipe in view of the Google Group disclosure does not




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disclose or suggest a base layer being a formulated flour and cheese mixture wherein the formulated flour is a dry mixture as claimed. The "Deep Dish Pizza" recipe does not suggest any motivation to modify the teachings thereof in order to provide the inventions as claimed. Additionally, the inventions of claims 1-26 would not have been obvious to one skilled in the art based on the "Deep Dish Pizza" recipe in view of the Google Group disclosure.

Based on the above and the arguments provided in appellant's Appeal Brief, appellant respectfully submits that the "Deep Dish Pizza" recipe in view of the Google Group disclosure does not render obvious the inventions of claims 1-26. Appellant respectfully requests reversal of the § 103 rejection of these claims based on the applied art.

Respectfully submitted,

JAMES D. KROL

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